

REMARKS

Claims 1-10 have been examined. Claims 1, 3, 5 and 7-10 have been rejected under 35 U.S.C. § 102(b), and claims 2, 4 and 6 have been rejected under 35 U.S.C. § 103(a).

I. Preliminary Matters

As a preliminary matter, the Examiner maintains that the title of the invention is not descriptive. Therefore, Applicant has amended the title and submits that the title should not be construed to limit the scope of the claims.

Also, the Examiner has objected to the specification and Fig. 3 for minor informalities. Applicant has made minor amendments to the specification and submits that such amendments overcome the objection. In addition, Applicant is submitting a proposed drawing correction for Fig. 3, and respectfully requests the Examiner to indicate whether such correction is acceptable in the next Office Action.

Further, the Examiner has objected to claim 9 due to an antecedent basis error. Accordingly, Applicant has amended claim 9, and submits that such amendment is not made in view of prior art and does not narrow the scope of the claims.

II. Rejection under 35 U.S.C. § 102(b) over JP 09134586 to Katsumata (“Katsumata”).

Claims 1, 3, 5 and 7-10 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Katsumata.

A. Claim 1

Applicant submits that claim 1 is patentable over the cited reference. For example, claim 1 recites that information stored in a storage means is read at a speed which is higher than or equal to a speed at which the information is reproduced. In an illustrative, non-limiting embodiment of the invention, by reading the information at a speed which is not lower than (i.e. higher than or equal to) a reproducing speed, a time lag can be removed for smooth reproduction.

The Examiner maintains that Katsumata teaches the recording/reproducing apparatus of claim 1. However, Katsumata fails to teach or disclose a speed at which information stored in storage means 25a is read or reproduced (para. [0026]-[0031]). Therefore, Applicant submits that Katsumata fails to teach or disclose that information stored in storage means 25a is read at a speed which is higher than or equal to a speed at which the information is reproduced.

Accordingly, Applicant submits that claim 1 is patentable over the cited reference, and respectfully requests the Examiner to withdraw the rejection.

B. Claims 3, 5 and 7-10

Since claims 3, 5 and 7-10 are dependent, either directly or indirectly, upon claim 1, Applicant submits that such claims are patentable at least by virtue of their dependency.

III. Rejection under 35 U.S.C. § 103(a) over Katsumata in view of U.S. Patent No. 6,449,226 to Kumagai ("Kumagai").

Claim 2 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Katsumata in view of Kumagai. However, since claim 2 is dependent upon claim 1, and Kumagai fails to cure the deficient teachings of Katsumata, Applicant submits that claim 2 is patentable over the cited reference.

IV. Rejection under 35 U.S.C. § 103(a) over Katsumata.

Claims 4 and 6 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Katsumata. However, Applicant submits that such claims are patentable over the cited reference. For example, claim 4 recites that after reproduction, a control means holds a prescribed time or quantity of information in the storage means, while discarding other information. Claim 6 recites that the prescribe time or quantity of information is identified by an identifying means. If the information has already been written into the storage means, the control means inhibits storage of the information.

The Examiner acknowledges that Katsumata fails to teach or suggest the above features. However, in a conclusory manner, the Examiner maintains that it would have been obvious for one of ordinary skill in the art at the time of the invention to have included the above features in order to provide more space on the hard disk and faster access.

Applicant submits that the proffered motivation for modifying the prior art is conclusory and wholly unsupported by the prior art.

It is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988, emphasis added). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *In re Kotzab*, 55 USPQ2d at 1316-1317; *see also* MPEP § 2142 (*quoting Ex parte Clapp*, 227 USPQ 972, 973 (B. Pat. App. & Inter. 1985)) (“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.”).

Here, the motivation proffered by the Examiner for modifying Katsumata to arrive at the claimed invention is simply not convincing. Katsumata does not even remotely suggest discarding or inhibiting storage of certain information. In addition, there is no suggestion in Katsumata that there is a need for such features. Therefore, Applicant submits that it would not have been obvious for one of ordinary skill in the art to include the features of claims 4 and 6 in the apparatus of Katsumata.

In addition, since claims 4 and 6 are dependent on claim 1, Applicant submits that such claims are patentable at least by virtue of their dependency.

V. Newly added claims

Applicant has added claims 11-13 to provide more varied protection for the present invention.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No.: 09/725,266

Attorney Docket No.: Q62049

VI. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

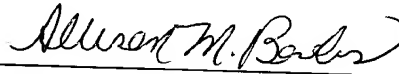
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APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE TITLE:

The title is changed as follows:

[RECORDING/REPRODUCING APPARATUS]RECORDING/REPRODUCING
APPARATUS FOR STORING A PRESCRIBED TIME OF INFORMATION

IN THE SPECIFICATION:

The specification is changed as follows:

Page 10, line 18 is amended as follows:

METHOD OF RECORDING [BIGGINING]BEGINNING DATA

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IN THE CLAIMS:

The claims are amended as follows:

1. (Once Amended) A recording/reproducing apparatus comprising:
storage means for storing information read from a recording medium on which the
information is written in a prescribed number of groups;
means for reading the information on said recording medium; and
control means for controlling the write in said storage means of at least a prescribed time
or quantity of information corresponding to a beginning address of each of said groups[.],
wherein the information on said storage means is read at a speed which is higher than or
equal to a speed at which the information is reproduced.

4. (Once Amended) A recording/reproducing apparatus according to claim 3, wherein said control means causes a prescribed time or quantity of information written in said storage means to be held therein and the other information written in said storage means to be held therein and the other information to be discarded after reproduction.

5. (Once Amended) A recording/reproduction apparatus according to claim 1, wherein said control means correlatively means said prescribed time or quantity of information written in said storage means and the recording medium in which it has been written.

6. (Once Amended) A recording/reproducing apparatus according to claim 5, further comprising:

means for detecting identification information for identifying said recording medium, wherein where said prescribed time or quantity of information contained in the recording medium identified by said identifying means has been already written in said storage means, said control means inhibits storage of the information into said storage means.

7. (Once Amended) A recording/reproducing apparatus according to claim 1, media, wherein

said control means causes said storage means to store said prescribed time or quantity of information relative to all said recording media held in said holding member.

8. (Once Amended) A recording/reproducing apparatus according to claim 7, wherein after said control means causes said storage means to store said prescribed time or quantity of information relative to all said recording media held in said holding member, it continues reproduction using the information remaining in said storage means.

9. (Once Amended) A recording/reproducing apparatus according to claim 7, wherein after said control means causes said storage means to store said prescribed time or quantity of information relative to all said recording media held in said holding [portion]member, it continues reproduction using the information recording in said recording media.

Claims 11-13 are added as new claims.